

II. Remarks

Reconsideration and re-examination of this application in view of the above amendments and the following remarks is herein respectfully requested. After entering this Amendment, claims 1-22 remain pending.

Claim Rejections – 35 U.S.C. §103

Claims 1, 3-19, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,695,813 to Boyle et al. (Boyle) in view of U.S. Patent No. 5,681,347 to Cathcart et al. (Cathcart) in view of U.S. Patent No. 4,619,643 to Bai (Bai) and in view of U.S. Patent No. 5,098,440 to Hillstead (Hillstead).

Claim 1 recites that the proximal end portion of the elongate control member is comprised of a high elongation material and the proximal end portion is bonded to a low elongation section of the elongate control member extending distally from the proximal end portion. Similarly, claim 21 specifies that the elongate control member is comprised of a low elongation material section for low elongation distal to the proximal end portion and the proximal end portion is comprised of a high elongation material section for tension absorption when the elongate control member is urged distally. This is clearly illustrated in Figure 12, where the high elongation material section is denoted by reference numeral 61 and the low elongation material section is denoted as reference numeral 63. As such two separate sections are defined, one proximal section and one distal section, that are jointed together to form the elongate control member.

Boyle, Cathcart, and Hillstead clearly do not teach an elongate control member including a high elongation material section and a low elongation material

section for manipulating a grasping portion. Rather, the examiner relies on Bai to teach this element. Bai teaches a catheter with alternating soft plastic and hard plastic rings. (abstract and Figure 20) However, the catheter of Bai is not an elongate control member as provided in the claims. Merely because Bai shows a catheter with alternating hard and soft plastic rings does not imply it would be obvious to make an elongate control member with a high elongation section and low elongation section for manipulating a grasper. “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

The design and use of the catheter in Bai is related to facilitating fluid flow in the circulatory system not the manipulation of a grasping device. Further, no factual evidence is provided that it would have been obvious to one of ordinary skill in the art to modify a control member for a grasping device based on a catheter design having an altogether distinct purpose and usage. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.*

Rather, it appears that the examiner has looked outside the scope of grasping devices to identify an attribute independently of the device as a whole. “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *Id.* at 1742.

Based on the reasoning supplied above, applicants submit that the combination cited by the examiner is improper. Accordingly, applicants contend that claims 1 and 21 are patentable over the cited art.

Claims 3-7, and 22 depend from claim 1 or 21 and are, therefore, patentable for at least the same reasons as given above in support of claim 1 and 21.

Claims 2 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyle in view of Cathcart, Bai, Hillstead and in view of U.S. Patent No. 5,484,444 to Braunschweiler et al. (Braunschweiler).

Claims 2 and 20 depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is requested.

Respectfully submitted by,

Dated: October 15, 2008

/Robert K. Fergan/
Robert K. Fergan (Reg. No. 51,674)

BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(734) 302-6000